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EXAMINER

SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,714

Applicant(s)

ROSS, BRUCE

Examiner

Eleni A. Shiferaw

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Response to Amendment

1. Applicant has filed petition for revival under 37 CFR 1.137(b), and petition has been granted.
2. Applicant's arguments/amendments with respect to amended claims 1, 5, and 10, added claims 15-18, and presently pending claims 1-18, filed on July 20, 2005 have been fully considered. Applicant's arguments with respect to claims 1-4 are not persuasive. And applicant's arguments with respect to claims 5-18 are moot in view of new ground(s) of rejection.

Response to Arguments

1. Applicant argues that:
 - a. Kawan requires a transaction authentication server to function (page 1 last paragraph).
 - b. Kawan and Griswold do not disclose fixed data file structure and/or middleware, such as APIs, OCXs, ActiveX control, libraries, and DLLs, on the smart card that permits sharing data/value between smart card issued to user and a point of sale system (page 11 par. 1-2).
 - c. Griswold smart token is not smart card, data stored is all on the system and is not written to the token until the end of play, and no motivation to combine the teachings of Griswold within the system of Kawan.

However, Examiner disagrees with applicant.

Regarding argument (a), Argument is not persuasive. The argued subject matter, (a) and (b) above, is not claimed for independent claim 1 and dependent claims 2-4. Applicant amends the preamble. However the amended subject matter on the preamble has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding argument (c), Argument is not persuasive. Griswold smart token is a smart card in the form of a coin-shape (col. 2 lines 43-45 and col. 3 lines 66-col. 4 lines 29). Data/account information or balance is stored in the memory of smart token and account information/dollar amount is updated at the end of the play (col. 9 lines 46-52, and col. 10 lines 24-33). And sufficient motivation to combine is provided in the Office Action page 5.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. Therefore, the examiner asserts that the system of the prior art, Kawan and Griswold teach or suggest the subject matter as recited in independent claim 1. Dependent claims 2-4 are also rejected at least by

virtue of their dependency on independent claims and by other reason set forth in this office action dated October 1, 2005. Accordingly, rejections for claims 1-4 are respectfully maintained.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kawan (U.S. Patent No. 6,289,324 B1).

As per claim 1, Kawan teaches a smart card including a memory with a defined data file structure, said data file structure (Kawan Col. 10 lines 27-31, col. 3 lines 1-7) comprising:-

at least one read only field (Kawan Col. 8 lines 33-38, Col. 10 lines 18-31, Fig. 2 No. 204);

at least one encrypted read/write field (Kawan Col. 4 lines 49-62); and

at least one non-encrypted read/write field (Kawan Col. 4 lines 33-43).

4. Claims 16, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Deo et al. (Deo, Patent No.: US 6,547,150 B1).

Regarding claim 16, Deo discloses a transaction system including:

at least one smart card reading and writing device or terminal (col. 3 lines 55-col. 4 lines 25, and col. 4 lines 41-67); and

a smart card having a fixed card file structure and a software application program with middleware that interfaces between the smart card and the smart card reading and writing device to control access and communication between the smart card reading and writing device and data stored on the card (col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3, and col. 4 lines 41-67; smart card with API and multiple applications stored on the memory wherein API interfaces the card data and the reader to control access and communication between the data stored in the card and the reader).

Regarding claim 17, Deo discloses a transaction system, wherein:

the middleware includes one or more of a DLL, an OCX, an APLET, or a library file (fig. 4 element 404).

Regarding claim 18, Deo discloses a transaction system, wherein:

an additional smart card authentication program contained on a separate card is resident on the smart card reading and writing device, said separate card having a different form factor

such as SIM/SAM or a custom punch shape (col. 4 lines 41-55; reader ... and many different smart cards ... from any smart card manufacturer).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, and 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Griswold et al. (Griswold, U.S. Patent 6,629,591 B1).

As per claim 2, Kawan teaches all the subject matter as described above.

Kawan does not explicitly teach the read only field including at least one of a manufacturer identification field, a card identification field and a theater identification field,

However Griswold teaches a smart card, wherein the read only memory includes at Least one of a manufacturer identification field, a card identification field and a theater identification field (Griswold Col. 6 lines 53-65; ROM inside the smart card contains secure information, PINs),

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the system of Kawan because it would securely keep security information (Griswold Col. 6 lines 53-65). Therefore it is obvious to have at least one of a manufacturer identification field, a card identification field

and a theater identification field included wherein the read only field because identification field would be secured.

As per claim 4, Kawan, and Griswold teach all the subject matter as described above. In addition Griswold teaches a smart card, wherein the non-encrypted read/write field includes at least one of a first dollar value display field, a second dollar value display field, a first point value display field, a second point value display field and a user defined field (Griswold Col. 10 lines 9-22).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the system of Kawan because it would display user transaction information without comprising data integrity.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Griswold et al. (Griswold, U.S. Patent 6,629,591 B1), and in further view of Carlisle et al. (Carlisle, (U.S. Patent No. 5,649,118).

As per claim 3, Kawan and Griswold teach all the subject matter as described above. Kawan and Griswold do not explicitly teach a transaction log in the smart card.

However Carlisle teaches a smart card log file (Carlisle Col. 13 lines 55-67, col. 14 lines 26-35) that reads on a smart card, wherein the encrypted read/write field includes at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field,

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Carlisle with in the combination system of Kawan and Griswold because it would contain a message that comprises sequence number, date and time, and the identification information (Carlisle col. 14 lines 26-35). Therefore it is obvious to include at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field because it would give a clear information about the smart card transaction.

8. Claims 5-6, 10, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Deo et al. (Deo, Patent No.: US 6,547,150 B1).

As per claim 5, Kawan teaches a transaction system (Kawan Col. 2 lines 21-27) including:

at least one smart card authorization device (Kawan Col. 4 lines 26-32, Fig. 2 No. 210, and col. 9 lines 27-43; **the ATM terminal is an authorization device that reads and authenticates/authorizes the data stored on the smart card**);

a communication interface (Kawan Col. 4 lines 26-32, Fig. 2 No. 208); and

a transaction verification server (Kawan Col. 3 lines 29-39);

Kawan discloses a software application program that interfaces the smart card data with card reader authenticator/ATM and financial institution host computer/banking institution for financial transaction. Kawan fails to explicitly teach data file structure/API/middleware, said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be

exchanged between the card and a reader regardless of the structure of an upper level user interface.

However Deo discloses wherein the smart card authorization device interacts with a defined data file structure provided on a smart card (Deo col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3, and col. 4 lines 41-55; reader interacts with the API stored on the smart card), said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface (col. 4 lines 4-25; API enabling data to be exchanged between the card and reader and remote computer system).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of middleware/API within the system of Kawan because it is well known in the art. One would have been motivated to incorporate the teachings of middleware because it would communicate the card's content, files of the card, the reader and remote host.

As per claim 10, Kawan teaches a transaction system (Kawan Col. 3 lines 29-56) comprising:

at least one smart card including a memory with a defined data structure (Kawan Col. 3 lines 1-7, col. 10 lines 18-31), wherein said defined data file structure includes at least one read only field (Kawan Fig. 2 No. 204), at least one encrypted read/write field (Kawan Col. 4 lines 49-62, col. 9 lines 17-26), and at least one non-encrypted read/write field (Kawan Col. 4 lines 33-43); and

read/write means for reading and writing data file to the memory of the smart card (Kawan Col. 4 lines 33-43, Fig. 2 No. 204, 206), wherein said read/write means includes an application program interface that utilizes a predefined set of commands to control the reading and writing of data to the memory card based on the defined data structure (Kawan Col. 3 lines 1-7, col. 10 lines 18-31).

Kawan discloses a software application program that interfaces the smart card data with card reader authenticator/ATM and financial institution host computer/banking institution for financial transaction. Kawan fails to explicitly teach data file structure/API/middleware, said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface.

However Deo discloses wherein the smart card authorization device interacts with a defined data file structure provided on a smart card (Deo col. 2 lines 50-59, col. 3 lines 55-col. 4 lines 3, and col. 4 lines 41-55; reader interacts with the API stored on the smart card), said defined data file structure on said smart card comprising a standardized fixed data structure that can interface with many different point of sale systems and reader types, enabling data to be exchanged between the card and a reader regardless of the structure of an upper level user interface (col. 4 lines 4-25; API enabling data to be exchanged between the card and reader and remote computer system).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of middleware/API within the system of Kawan

because it is well known in the art. One would have been motivated to incorporate the teachings of middleware because it would communicate the card's content, files of the card, the reader and remote host.

As per claim 6, Kawan and Deo teach all the subject matter. In addition Kawan teaches a transaction system, wherein said data file structure (Kawan Col. 10 lines 18-31) comprises:

- at least one read only field (Kawan Col. 8 lines 33-38, Col. 10 lines 18-31, Fig. 2 No. 204);
- at least one encrypted read/write field (Kawan Col. 4 lines 49-62); and
- at least one non-encrypted read/write field (Kawan Col. 4 lines 33-43).

As per claim 14, Kawan and Deo teach all the subject matter. In addition Kawan teaches a transaction system, wherein the read/write means further comprises means for encrypting and decrypting data read from and written to said encrypted data field (Kawan Col. 10 lines 12-17).

As per claim 15, Kawan and Deo teach all the subject matter. In addition Kawan teaches a transaction system, wherein the predefined commands include a set of general commands, a set of read commands and a set of write commands (Kawan Col. 10 lines 18-31, col. 4 lines 33-43).

9. Claims 7, 9, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Deo et al. (Deo, Patent No.: US 6,547,150 B1) and further in view of Griswold et al. (Griswold, U.S. Patent 6,629,591 B1).

As per claims 7 and 11 Kawan and Deo teach all the subject matter as described above. It is well known to store serial number identifier on the read only memory of a smart card. However Kawan and Deo do not explicitly teach serial number/SIM stored on read only memory of the smart card. Griswold teaches a transaction system, wherein the read only memory includes at least one of a manufacturer identification field, a card identification field and a theater identification field (Griswold Col. 6 lines 53-65; ROM inside the smart card contains secure information, PINs).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to store identifier information on read only memory of the smart card. One would have been motivated to do so because it securely stores sensitive data, like the identity of the serial number that need not be changed/modified, on nonvolatile memory.

As per claim 9, Kawan, Doe, and Griswold teach all the subject matter as described above. In addition Griswold teaches a transaction system, wherein the non-encrypted read/write field includes at least one of a first dollar value display field, a second dollar value display field, a first point value display field, a second point value display field and a user defined field (Griswold Col. 10 lines 9-22).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the combination system of Kawan and Doe because it would display user transaction information without comprising data integrity.

As per claim 13, Kawan, Deo, and Griswold teach all the subject matter as described above. In addition Griswold teaches a transaction system, wherein the non-encrypted read/write field includes at Least one of a first dollar value display field, a second dollar value display field, a first point value display field, a second point value display field and a user defined field (Griswold Col. 10 lines 9-22).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Griswold with in the system of Kawan and Deo because it would display user transaction information without comprising data integrity.

10. Claims 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,289,324 B1) in view of Deo et al. (Deo, Patent No.: US 6,547,150 B1), and further in view of Carlisle et al. (Carlisle, (U.S. Patent No. 5,649,118).

As per claims 8, and 12 Kawan, Deo, and Griswold, teach all the subject matter as described above. Kawan, Deo, and Griswold do not explicitly teach smart card log file.

Carlisle teaches a smart card log file (Carlisle Col. 13 lines 55-67, col. 14 lines 26-35) that reads on a transaction system, wherein the encrypted read/write field includes at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Carlisle with in the combination system of Kawan, Deo, and Griswold because it would contain a message that comprises sequence number,

date and time, and the identification information (Carlisle col. 14 lines 26-35). Therefore it is obvious to include at least one of a transaction log field, an issue date field, a first dollar value field, a second dollar value field, a first point value field, a second point value field and a ticket storage field because it would give a clear information about the smart card transaction.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eleni Shiferaw


October 1, 2005


Primary Examiner
A02131
10/9/05